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OFFICE OF PETITIONS

In re Application of
Dabak, et al.
Application No. 09/885,878
Filed: 20 June, 2001
Attorney Docket No. TI-131293

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ON PETITION

This is a decision on a petition filed on 24 May, 2006, under 37 C.F.R. §1.137(b).

For the reasons forth below, the petition under 37 C.F.R. §1.137(b) is **DISMISSED**.

BACKGROUND

The record indicates:

- Petitioner failed to reply timely and properly to the final Office action mailed on 11 October, 2005, with reply due absent extension of time on or before 11 January, 2006;
- Petitioner filed a reply in the form of an after final amendment (with request and fee for extension of time) on 6 March, 2006, which reply is not of right,¹ and the Examiner mailed an Advisory Action on 20 March, 2006;

¹ A proper reply is a an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, or an RCE (with fee and submission). (See: MPEP §711.03(c).)

- on 11 April, 2006, Petitioner filed a Notice of Appeal and fee (with request and fee for extension of time), after which filing Petitioner had two (2) months absent extension of time—i.e., until Monday 11 June, 2006—to file the Appeal Brief and fee, however, on 24 May, 2006, Petitioner filed instead the instant petition with a reply in the form of a request for continued examination and fee with a submission in the form of an amendment 37 C.F.R. §1.114;
- thus, the instant application apparently did not go abandoned by operation of law and remained and remains pending (and it does not appear that the Office mailed the Notice of Abandonment before the instant petition was filed);
- Petitioner also has made the statement of unintentional delay—thus, Petitioner appears to have satisfied the regulatory requirements under 37 C.F.R. §1.137(b), however, this appears to be moot.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).²

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.³

Delays in responding properly raise the question whether delays are unavoidable.⁴ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁵

² 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

³ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁴ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁵ See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

And the Petitioner must be diligent in attending to the matter.⁶ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁷))

Allegations as to Unintentional Delay

The requirements for relief under the provisions of 37 C.F.R. §1.137(b) are: petition, fee, reply, showing of unintentional delay, and—where appropriate—a terminal disclaimer and fee.

The record (including the petition filed on 30 May, 2006) does not necessitate a finding that the delay between midnight 19 June, 2005 (date of abandonment), and 30 May, 2006 (date of filing of grantable petition), was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on the duty of candor and good faith of Applicants (Ratcliff, Kleiwer and Allred) and their Counsel/Petitioner (Carlton H. Hoel (Reg. No. 29,934) when accepting Petitioner's representation that the delay in filing the response was unintentional.⁸

While it appears that Petitioner has satisfied the requirements of the regulation, it also appears that the application never went abandoned and the issue is moot.

CONCLUSION

The petition under 37 C.F.R. §1.137(b) is **dismissed as moot**.

The application is released to the Examiner in Technology Center 2600 for further processing in due course.

⁶ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

⁷ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁸ See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

A handwritten signature in black ink, appearing to be 'J. Gillon', with a stylized flourish extending to the right.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions